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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,783	05/24/1999	HANS-JURGEN FISCHER	10191/913	3361

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EXAMINER

WASYLCHAK, STEVEN R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,783

Applicant(s)

FISCHER ET AL.

Examiner

Steven R. Wasylchak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RESPONSE TO APPELLATE BRIEF

1. In view of the Appellate Brief filed on August 22, 2003, PROSECUTION IS HEREBY REOPENED for the reasons set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 8-17 are pending. Response to attorney's arguments are considered moot in view of examiner's response to the appellate brief.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A storage device, per se, does not perform "checking", "posting", "generating" or "transmitting" as these functions are performed by

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the CPU or micro controller. Also, "the debit information computer" has a vague meaning as it appears that the computer is not strictly dedicated to debit information processes.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8-17 (all preliminary amendments that cancel claims 1-7 in PCT /DE97/00995) are rejected under 35 U.S.C. 102(b) as being anticipated by Chaum et al. (US 5,485,520).

As per claim 8,

A method for posting debit information to a mobile intelligent storage device using a terminal, the terminal being in a wireless, secure communication with a computer, the method comprising the steps of:

-performing a mutual dynamic authenticity test between the computer, the terminal and the storage device using at least one data word, the at least one data word constantly changing; / col 3, L 10-45, L 54 to col 4, L18; *fig 1 (wireless)*; **fig 5A-B (see payment/center under complex frame protocol, smart card)**; **fig 5D-C (see command time line with data frame which includes debit data and frame**

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markers); col 23, line 41 to col 24, line 24; col 25, line 52 to col 26, line 31, col 27, line 63 to col 28, line 52.

-generating, by one of the computer and the terminal, the debit information computer; / col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L 18; **fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers)**

-processing, by the storage device, the debit information; / claim 15; col 2, L 38-52; col 3, L 10-45, L 54 to col 4, L 18; **fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 3-17(memory for database), line 41 to col 24, line 24; col 25, line 52 to col 26, line 31, col 27, line 63 to col 28, line 52; col 22, L 18-19(bi-directionality)**

-before an interrupt-sensitive time period, transmitting a first data word of the at least one data word from the storage device to the terminal, the first data word being generated for the mutual dynamic authenticity test; / col 3, L 10-45; **fig 4A (700, 702); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 41 to col 24, line 24; col 27, line 63 to col 28, line 52; col 15, L 22-64; col 16, L 13-31; col 22, L 18-19)**

-during the interrupt-sensitive time period, transmitting a particular signal from the terminal to the storage device, the particular signal including a posting triggering signal, a posting data record, an identifier generated using the first data word and a second data word of the at least one data word generated by one of the computer and the

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terminal; / col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18; **fig 4A (700, 702); fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 41 to col 24, line 24; col 25, line 52 to col 26, line 31, col 27, line 63 to col 28, line 52; col 22, L 18-19**

-checking, by the storage device, the identifier; / col 3, L 10-45, L 54 to col 4, L18; **fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 41 to col 24, line 24; col 25, line 52 to col 26, line 31, col 27, line 63 to col 28, line 52; ; col 22, L 18-19**

-posting, by the storage device, the debit information as a function of the posting data record; / col 2, L 1-22; col 4, L 1-18, col 15, L 22-64(identifier, handshake, interrupt, buffer); col 5, L 55-63; col 6, L 47-51; **fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 22, L 18-19**

-generating, by the storage device, a further identifier as a function of the second data word; / col 3, L 10-45, L 54 to col 4, L18; **col 21, L 38-44(identifier);col 25, L 3 to 35 (identifier); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 41 to col 24, line 24; col 25, line 52 to col 26, line 36("redundant frames")**

-transmitting, by the storage device, a confirmation signal and the further identifier to the computer via the terminal, the confirmation signal being provided to indicate that the

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debit information has been posted, the confirmation signal being transmitted from the terminal to the computer one of during and outside of the interrupt-sensitive time period.

/ col 3, L 10-45, L 54 to col 4, L18; **fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame markers); col 23, line 41 to col 24, line 24; col 25, line 52 to col 26, line 36, col 27, line 63 to col 28, line 52; col 21, L 38-44(identifier); col 16, L 53-65; col 22, L 18-19; col 26, L 13-35(discontinuous intervals are during and outside of the interrupt-sensitive time period)**

As per claim 9,

The method according to claim 8, further comprising the step of: after the confirmation signal is transmitted, receiving an acknowledgment signal for the posted debit information from the computer by the terminal. / col 3, L 10-45, L 54 to col 4, L18

As per claim 10,

The method according to claim 8, wherein the mobile intelligent storage device includes an IC card. / abstract

As per claim 11,

The method according to claim 8, wherein the wireless secure communication is performed via a computer station. / fig 1

As per 12;

The method according to claim 8, wherein the posting data record includes a transaction data record for creating a log book entry in the storage

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device. / col 1, L 6-15; col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18

As per claim 13,

The method according to claim 12, wherein the transaction data record is supplemented by an acknowledgment signal which is transmitted outside of the interrupt-sensitive time period. / fig 5D,C; col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18

As per 14,

The method according to claim 12, wherein the storage device is formed using a plurality of page records for storing the debit information, and the method further comprising the steps of:

- temporarily storing the transaction data record during the interrupt sensitive time period on a particular page record of the plurality of page records; and / col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18
- outside of the interrupt-sensitive time period, transmitting the transaction data record to a log book data file. / col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18

As per claim 15,

The method according to claim 14, further comprising the step of: until the transmitting of the transaction data record to the log book data file is performed, blocking the storage device for posting the debit information. / col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18

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As per claim 16,

The method according to claim 8, wherein the method is utilized to post use fee debit information. / claim 15; col 1, L 6-15; col 2, L 38-52; col 2, L 65 to col 3, L 9; col 3, L 10-45, L 54 to col 4, L18

As per claim 17,


The method according to claim 16, wherein the method is utilized to collect a toll for a motor vehicle. / abstract

This action is NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Wasylchak whose telephone number is (703) 308-2848. The examiner can normally be reached on Monday-Thursday from 9:00 a.m. to 7:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylchak


11/15/03


DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER